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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,445	08/17/2006	Satoru Nemoto	062007	7483
38834	7590	04/30/2009		EXAMINER
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP				THEODORE, MAGALI P
1250 CONNECTICUT AVENUE, NW				
SUITE 700			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20036			1791	
			MAIL DATE	DELIVERY MODE
			04/30/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/564,445	NEMOTO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Magali P. Théodore	1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10 February 2009.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.  
 4a) Of the above claim(s) 1,3,4,7 and 8 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 2,5,6 and 9-19 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 12 January 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/12/2006</u> .                                               | 6) <input type="checkbox"/> Other: _____ .                        |

***Election/Restrictions***

Applicant's election with traverse of Group II, claim 2, in the reply filed on February 10, 2009 is acknowledged. The traversal is on the ground(s) that Groups II and IV satisfy the combination of categories provided under 37 CFR 1.475(b) and satisfy unity of invention. This is not found persuasive because Applicant has given no substantive explanation of why unity of invention is satisfied.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1, 3-4 and 7-8 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on February 10, 2009.

***Claim Rejections - 35 USC § 112***

Claims 2, 5-6 and 8-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claims 2, 5-6 and 8-19** are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Each of **claims 5-6 and 8-19** recites "the method or device." A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 USC 112, second paragraph. MPEP 2173.05(p) II. IPXL Holdings

v. Amazon.com, Inc., 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005).

For the purpose of search and examination, the claims have been examined as "The method."

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, 5-6, 9-10 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Saito et al. (US 2002/0088767 A1), henceforth **Saito**.

Regarding **claim 2**, Saito teaches supplying molding material to a rotating molding die (figure 9:32) by using a movable rotating drop supply (figure 9:20) that has a drop holding mechanism (figure 9:23-24). The die's movement follows that of the holding mechanism (figure 7:arrows in 20 and 30). The holding mechanism approaches the die in an area where the two paths of rotation overlap or nearly overlap (figure 9:M). There, the holding mechanism inserts the drop into the concavity (figure 11:43) of the female die (figure 9:32).

Regarding **claim 5**, Saito teaches forcibly inserting the drop (throwing, 0125: last line).

Regarding **claim 6**, Saito teaches plural holding mechanisms (figure 9:23-24) and plural male and female dies (0109).

Regarding **claim 9**, Saito teaches that the die rotates in a circular path (figure 9:30 arrow) and the drop supply follows the die (figure 9:30 arrow). The radius moves around the circle's center and the system's movement is elastic in that mechanical energy is conserved by the transfer of kinetic energy to the drop as it is forcibly inserted.

Regarding **claim 10**, Saito teaches that when the holding mechanism approaches the rotating die, the holding mechanism tilts at a specific angle to the normal of the drop supply (0105: middle).

Regarding **claim 19**, Saito teaches molding a preform (0015).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Saito** as applied to claim 2 above, and further in view of **Ingram** (US 6,123,880).

Regarding **claim 8**, Saito does not teach using a lift block. However, Ingram teaches using a lift block (figure 1:42) to raise and lower a part of a rotary molding mechanism that handles the work (4:1-5). Therefore, it would have been obvious to

combine Ingram's use of a lift block with the steps taught by Saito lower the holding mechanism to hold the drop to obtain predictable results with a reasonable expectation of success. When the lift block moves from rest or changes the direction of its movement, the block inherently accelerates.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Saito** as applied to claim 2 above, and further in view of Winter et al. (US 6,152,723), henceforth **Winter**.

Regarding **claim 11**, Saito does not teach a guide or a cam. However, Winter a holding mechanism (figure 7:45) that moves along a guide (figure 7: rail). The holding mechanism has a cam follower (figure 7:54) that follows a cam (figure 7:55). Therefore it would have been obvious to one of ordinary skill in the art to combine Winter's use of guide, cam and cam follower with the steps taught by Saito to achieve predictable results with a reasonable expectation of success. The placement of the cam outside or inside the drop supply is an obvious matter of engineering design choice and does not impart patentable distinction to the claim.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Saito** in view of **Winter** as applied to claim 11 above, and further in view of Suzuki et al. (US 4,312,437), henceforth **Suzuki**.

Regarding **claim 12**, Saito does not teach oscillation. However, Suzuki teaches using oscillation to help release the work from the machine (6:6-9). Therefore, it would have been obvious to one of ordinary skill in the art to have Saito's mechanism oscillate

as it approaches the die because Suzuki teaches using oscillation to help release the work. *Alternatively*, it would have been obvious to one of ordinary skill in the art to combine Suzuki's oscillation with the steps taught by Saito in order to achieve predictable results with a reasonable expectation of success.

Claim 13/11 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Saito** in view of **Winter** as applied to claim 11 above, and further in view of **Choinski** (US 2002/0093126 A1).

Regarding **claims 13/11**, Saito teaches that the holding mechanism abuts the die (figure 9:M) . Winter teaches that the cam follower (figure 7:54) abuts the cam (figure 7:55).

Saito does not teach a support. However, Choinski teaches supporting a holding mechanism with a support (figure 12:71-73). The support is biased or held on with a force toward the outside of a wheel to which the holding mechanism is attached (figure 11). The support moves inward and outward (figures 12-14) along a guide (figure 12:74). As the support moves, the angle between the guide and the support is adjusted (figures 12-14). The holding mechanism does not move outward from the center of rotation (figure 11). Therefore it would have been obvious to one of ordinary skill in the art to combine these functional features taught by Choinski with the steps taught by Saito in order to achieve predictable results with a reasonable expectation of success.

Claim 13/12 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Saito** in view of **Winter** and **Suzuki** as applied to claim 12 above, and further in view of **Choinski**.

Regarding **claims 13/12**, Saito teaches that the holding mechanism abuts the die (figure 9:M) . Winter teaches that the cam follower (figure 7:54) abuts the cam (figure 7:55).

Saito does not teach a support. However, Choinski teaches supporting a holding mechanism with a support (figure 12:71-73). The support is biased or held on with a force toward the outside of a wheel to which the holding mechanism is attached (figure 11). The support moves inward and outward (figures 12-14) along a guide (figure 12:74). As the support moves, the angle between the guide and the support is adjusted (figures 12-14). The holding mechanism does not move outward from the center of rotation (figure 11). Therefore it would have been obvious to one of ordinary skill in the art to combine these functional features taught by Choinski with the steps taught by Saito in order to achieve predictable results with a reasonable expectation of success.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Saito** as applied to claim 2 above, and further in view of Vogel et al. (US 6,514,448 B1), henceforth **Vogel**.

Regarding **claim 14**, Saito does not teach a fixing member or a controlling guide. Vogel teaches a holding mechanism (figure 8:19) is supported by a fixing member (figure 8:20) which moves in an eccentric circle. The fixing member's movement is

controlled by a controlling guide (figure 8:31-33). The controlling guide is on a cam. Therefore, it would have been obvious to one of ordinary skill in the art to combine these functions taught by Vogel with the steps taught by Saito to achieve predictable results with a reasonable expectation of success.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Saito** in view of **Vogel** as applied to claim 14 above, and further in view of **Zoppas** (US 6,422,379 B1).

Regarding **claim 15**, Saito teaches that each of the molding die and the holding mechanism travels on a circular path. Saito does not teach radial extension means. However, Zoppas teaches transporting preforms (figure 1:1) using a radial extension means (figure 3:31) on a media on a wrapping driving device (figure 1:2). Therefore, it would have been obvious to one of ordinary skill in the art to combine the functions taught by Zoppas with the steps taught by Saito in order to achieve predictable results with a reasonable expectation of success.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Saito** in view of **Vogel** as applied to claim 14 above, and further in view of **Winter** and **Choinski**.

Regarding **claim 16**, Saito teaches that the holding mechanism abuts the die (figure 9:M) .

Saito does not teach a cam or a cam follower. However, Winter teaches a cam follower (figure 7:54) that abuts the cam (figure 7:55). Therefore it would have been obvious to one of ordinary skill in the art to combine the use of a cam and cam follower with the steps taught by Saito in order to achieve predictable results with a reasonable expectation of success.

Saito does not teach a support. However, Choinski teaches supporting a holding mechanism with a support (figure 12:71-73). The support is biased or held on with a force toward the outside of a wheel to which the holding mechanism is attached (figure 11). The support moves inward and outward (figures 12-14) along a guide (figure 12:74). As the support moves, the angle between the guide and the support is adjusted (figures 12-14). The holding mechanism does not move outward from the center of rotation (figure 11). Therefore it would have been obvious to one of ordinary skill in the art to combine these functional features taught by Choinski with the steps taught by Saito in order to achieve predictable results with a reasonable expectation of success.

Regarding **claim 17**, Saito teaches that the path around the eccentric circle is formed by vertical rotation (figure 9; the words "upper" and "descend" indicate that both circles are in the vertical plane).

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Saito** as applied to claim 2 above.

Regarding **claim 18**, Saito does not teach adjusting the velocity of the holding mechanism. However, since Saito's method requires the holding mechanism and the

die to arrive at the same place at the same time, it would have been obvious to one of ordinary skill in the art to arrange that coincidence by adjusting the velocity of the holding mechanism to that of the molding die.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Magali P. Théodore whose telephone number is (571) 270-3960. The examiner can normally be reached on Monday through Friday 9:30 a.m. to 6:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina A. Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Magali P. Théodore/  
Examiner, Art Unit 1791

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Supervisory Patent Examiner, Art Unit 1791